



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,979	01/18/2002	Melanie Maas-Brunner	49769	8231

26474 7590 12/17/2003

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

PRICE, ELVIS O

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 12/17/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,979

Applicant(s)

MAAS-BRUNNER ET AL.

Examiner

Elvis O. Price

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) 11,13,17,19,23,25,27 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,14-16,18,20-22,24,26,28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 111-30 are pending in the application.
2. Claims 11, 13, 17, 19, 23, 25, 27 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11. The traversal is on the grounds that the claims of Groups I and II do relate to a single general inventive concept because the two sets of claims are related as a combination and subcombination of process steps.

This argument is not convincing because the Examiner has shown previously, in Office action dated 10/02/03, that the hydrogenated alcohols of Group II can be prepared by a materially different process than that of the process of Group I. It is standard knowledge in the art that brominated hydrocarbon compounds (optional substituted with other functional organic groups) can be subjected to base to undergo hydrogen bromine elimination reactions to produce the corresponding unsaturated hydrocarbon which can be hydrogenated to produce the corresponding hydrogenated hydrocarbon. Thus, the hydrogenated alcohols of Group II can be prepared by treating 2,5,5-trimethyl-3,4-dibromo-2-hexanol with base (e.g., sodium hydride) to generate the corresponding alkynol and the said alkynol can be used in the process of Group II to prepare the hydrogenated alcohol. Thus, and undue burden of search would be required to prosecute the two distinct group of inventions.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

The information disclosure statement complies with the provisions of 37 CFR 1.97, 1.98 and MPEP02 § 609. It has been placed in the application file, and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 14-16, 18, 20-22, 24, 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottfried et al. {U.S. Pat. 2,488,082}, in view of Vedage {US Pat. 5,444,170}.

Applicants claim, in brief, a process for preparing at least one hydrogenated alcohol comprising, (1) reacting an alkali or alkali earth metal hydroxide with at least one alcohol to form a mixture, (2) reacting at least one ketone compound with at least one alkyne and the said mixture to form and unsaturated alcohol, (3) hydrogenating the unsaturated alcohol to form the hydrogenated alcohol mixture and (4) distilling the hydrogenated alcohol mixture to separate the hydrogenated alcohol before recycling the unsaturated alcohol and solvent.

Gottfried et al. teach a process for preparing an unsaturated alcohol comprising reacting and alkali hydroxide with and alcohol to form a mixture then reacting a ketone (acetone) with and alkyne (acetylene) and the said mixture to form the unsaturated alcohol (alkynol) (see Examples 1 and 2). The difference between applicants' claimed invention and the reference is that the reference does not teach hydrogenating the unsaturated alcohol to prepare the hydrogenated alcohol.

Vedage teaches a process for hydrogenating acetylenic compounds (e.g., alkynols prepared by condensing ketones with acetylene) so as to prepare hydrogenated alcohols (see Comp. Example 1, Example 2, and Example 5).

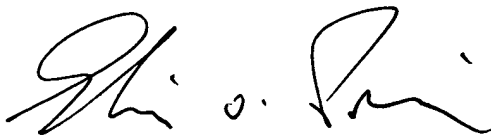
It would have been clearly *prima facie* obvious to one of ordinary skill in the art, in view of the cited references, to arrive at the presently claimed invention, because Gottfried et al. teach a similar process for preparing an unsaturated compound (condensing and ketone with acetylene with a previously prepared alkali alcoholate) and Vedage teaches a process for hydrogenating acetylenic compounds so as to prepare the hydrogenated alcohol.

One having ordinary skill in the art, desiring to arrive at alternative methods of preparing hydrogenated alcohols, depending on cost, convenience and availability of materials, would have been motivated to couple the hydrogenation method taught by Vedage with the alkynol production method taught by Gottfried et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elvis O. Price whose telephone number is 703 605-1204. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 703 308-4532. The fax phone numbers for the organization where this application or proceeding is assigned is 703 308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

A handwritten signature in black ink, appearing to read 'J. Richter', is written over the text '1235.'.

EOP

December 15, 2003